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REMARKS

Claims 1-40 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over combinations of Maier, *et al.* (U.S. Patent No. 6,463,127), Chow, *et al.* (U.S. Patent No. 6,819,945), Hunt, *et al.* (U.S. Patent No. 5,499,288), and Rogers, *et al.* (6,785,379). As will be shown below, none of the references, either alone or in combination, teaches or suggests a method, system, or computer program product for destination device initiated caller identification as claimed in the present application. Claims 1-40 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-40.

In an effort to move the case forward, Applicants have amended the claims by adding two new claims: Independent method claim 41 and independent system claim 42. The Office Action states in its numbered paragraph 3 that claims 6 and 17 are allowable if rewritten in independent form. New claims 41 and 42 are claims 6 and 17 respectively rewritten in independent form including all the limitations of their base claims and any intervening claims.

Claims 1 and 12 are the base claims for new independent claims 41 and 42 respectively. The Office Action rejects claims 1 and 12 as obvious over Maier in view of Chow under 35 U.S.C. § 103(a). Applicants explain in detail below that in fact claims 1 and 12 are not obvious over Maier in view of Chow and that claims 6 and 17, which depend from claims 1 and 12, therefore are in fact allowable in their original form. Applicants present new claims 41 and 42 in an effort to advance the case with no prejudice to Applicants' arguments that claims 1 and 12 are not obvious over Maier in view of Chow.

Claim Rejections – 35 U.S.C. § 103

Claims 1-40 stand rejected under 35 U.S.C § 103(a) as unpatentable over combinations of Maier, *et al.* (U.S. Patent No. 6,463,127), Chow, *et al.* (U.S. Patent No. 6,819,945), Hunt, *et al.* (U.S. Patent No. 5,499,288), and Rogers, *et al.* (6,785,379). Applicants

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respectfully traverse each rejection. To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Maier and Chow

Claims 1-2, 4, 7-11, 12-13, 15, 18-22, 23-24, 26, 29-30, 32-35, 37-40 stand rejected under 35 U.S.C § 103(a) as unpatentable over Maier in view of Chow. The proposed combination of Maier and Chow cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The combination Of Maier and Chow

Does Not Teach all Of Applicants' Claim Limitations

Regarding claim 1, the office action states that column 1, lines 42-43, and column 2, lines 34-37, of Maier discloses:

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responsive to detecting a call extended to a destination device, extending a request from said destination device to an origin device requesting a voice utterance of the caller utilizing said origin device

What Maier at column 1, lines 42-43, and column 2, lines 34-37, actually discloses is a "calling party is prompted to respond to an inquiry." Maier's prompting a calling party to respond to an inquiry does not disclose, responsive to detecting a call extended to a destination device, extending a request from said destination device to an origin device requesting a voice utterance of the caller utilizing said origin device as claimed in the present application. That is, Maier mentions only a prompt for a response. Maier does not disclose detecting a call extended to a destination device, extension of a request from a destination device to an origin device, a voice utterance, or any other limitation of this element of the claims.

In further regard to claim 1, the office action states that column 5, lines 50-54, of Maier discloses:

identifying, at said destination device, a caller identity associated with said voice utterance, such that a callee receiving said call at said destination device is informed of said caller identity before speaking with said caller

What Maier at column 5, lines 50-54, actually discloses is "When the receiving party repeats these numbers, the system utilizes the voice verification technology to match speech patterns..." In Maier, the identity of the callee, not the caller, is verified by providing voice samples. The receiving party and the verification system of Maier do not disclose identifying, at said destination device, a caller identity associated with said voice utterance, such that a callee receiving said call at said destination device is informed of said caller identity before speaking with said caller as claimed in the present application.

Regarding claim 29, Applicants recite the first element as follows:

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detecting a voice utterance of a caller at a destination device receiving a call

The Office Action does not mention any reference regarding the anticipation of the first element of claim 29. Applicants submit that nothing in the prior art teaches this claim limitation. Claim 29 therefore is patentable and should be allowed.

In further regard to claim 29, the office action states that column 5, lines 50-54, of Maier discloses:

authenticating an identity of said caller from said voice utterance at said destination device

What Maier at column 5, lines 50-54, actually discloses is “When the receiving party repeats these numbers, the system utilizes the voice verification technology to match speech patterns...” In Maier, the identity of the callee, not the caller, is verified by providing voice samples. The receiving party and the verification system of Maier do not disclose authenticating an identity of said caller from said voice utterance at said destination device.

Regarding claim 29, the office action states that column 5, lines 59-60, of Maier discloses:

enabling output of said authenticated identity from said destination device, such that a callee accessing said destination device is informed of an identity of said caller

What Maier at column 5, lines 59-60, actually discloses is:

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If the responses do not match, the monitored individual fails the verification session, and the system creates an exception. Preferably, this exception prompts the system to notify a supervisor.

That is, Maier discloses merely notifying a supervisor if a person alleging to be an offender under house arrest fails the telephone verification session. In Maier, the identity of the person alleging to be an offender under house arrest cannot be verified. Maier's notifying a supervisor because a callee cannot be identified does not disclose enabling output of said authenticated identity from said destination device, such that a callee accessing said destination device is informed of an identity of said caller as claimed in the present application.

No Suggestion or Motivation to Combine Maier and Chow

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation to combine Maier and Chow. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine Maier and Chow must come from the teaching of either Maier or Chow themselves, and the Examiner must explicitly point to the teaching within Maier or Chow suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "indsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action states no rationale for motivation to combine other than the assertion that "...it would have been obvious to one ordinarily skilled in the art at the time of the invention to modify the teachings of Maier...." The Office Action cites no explicit reference to either Maier or Chow regarding this bare assertion. In fact, it is not possible

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to find such a teaching of motivation to combine in the present references because Maier is concerned with speaker verification and minimal supervisory reporting of offenders under house arrest, while Chow is directed toward providing a novel wireless centrex service that untethers subscribers from the immobility associated with traditional phones. Absent a showing of a motivation to combine, the Examiner has impermissibly used hindsight occasioned by Applicants' own teaching to reject the claims. The Examiner has not pointed to any disclosure in Maier or Chow suggesting destination device initiated caller identification according to context within the meaning of the claims of the present application. As such, the proposed combination of Maier and Chow cannot establish a *prima facie* case of obviousness.

No Reasonable Expectation of Success in the
Proposed Combination of Maier and Chow

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in the proposed combination of Maier and Chow. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of success in a proposed modification if the proposed modification changes the principle of operation of either Maier or Chow. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

There can be no reasonable expectation of success in a proposed combination of speaker verification and minimal supervisory reporting of offenders under house arrest of Maier with providing a novel wireless centrex service that untethers subscribers from the immobility associated with traditional phones of Chow to produce destination device initiated caller identification as claimed in the present application. On the contrary, providing a novel wireless centrex service that untethers subscribers from the immobility associated with traditional phones of Chow would clearly change the principle of monitoring offenders under house arrest of Maier. That is, the principle of operation of

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Maier, speaker verification and minimal supervisory reporting of offenders under house arrest, is changed completely, and in fact will not function at all, with the addition of Chow's providing a novel wireless centrex service that untethers subscribers from the immobility associated with traditional phones. The proposed combination of Maier and Chow therefore cannot possibly support a *prima facie* case of obviousness.

Maier combined with Chow does not disclose each and every element of claims 1 and 29. There is no suggestion to combine Maier and Chow in either reference, and there is no reasonable expectation of success in the proposed combination. The Office Action therefore does not establish a *prima facie* case of obviousness under 35 U.S.C. § 103. Applicants respectfully traverse the rejection to each of claims 1 and 29 and request that claims 1 and 29 be allowed.

Relations Among Claims

Independent claim 1 claims method aspects of destination device initiated caller identification according to embodiments of the present invention. Independent claims 12 and 23 respectively claim system and computer program product aspects of destination device initiated caller identification according to embodiments of the present invention. Claim 1 is allowable for the reasons set forth above. Claims 12 and 23 are allowable because claim 1 is allowable. The rejections of claims 12 and 23 therefore should be withdrawn, and claims 12 and 23 should be allowed.

Claims 2-11, 13-22, and 24-28 depend respectively from independent claims 1, 12, and 23. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Maier and Chow does not disclose or suggest each and every element of the independent claims and no other references refer to the elements of the independent claims, no proposed combination of references can possibly disclose or suggest each and every element of any dependent claim. The rejections of Claims 2-11, 13-22, and 24-28 therefore should be withdrawn, and these claims also should be allowed.

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Independent claim 29 claims method aspects of destination device initiated caller identification according to embodiments of the present invention. Independent claims 34 and 39 respectively claim system and computer program product aspects of destination device initiated caller identification according to embodiments of the present invention. Claim 29 is allowable for the reasons set forth above. Claims 34 and 39 are allowable because claim 29 is allowable. The rejections of claims 34 and 39 therefore should be withdrawn, and claims 34 and 39 should be allowed.

Claims 30-33, 35-38, and 40 depend respectively from independent claims 29, 34, and 39. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Maier and Chow does not disclose or suggest each and every element of the independent claims and no other references refer to the elements of the independent claims, no proposed combination of references can possibly disclose or suggest each and every element of any dependent claim. The rejections of Claims 30-33, 35-38, and 40 therefore should be withdrawn, and these claims also should be allowed.

Conclusion

Claims 1-40 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over combinations of Maier, *et al.* (U.S. Patent No. 6,463,127), Chow, *et al.* (U.S. Patent No. 6,819,945), Hunt, *et al.* (U.S. Patent No. 5,499,288), and Rogers, *et al.* (6,785,379). For the reasons set forth above, however, the proposed combination of Maier, Chow, Hunt, and Rogers fails to establish a *prima facie* case of obviousness for claims 1-40. The rejection of claims 1-40 should therefore be withdrawn, and the claims should be allowed. Reconsideration of claims 1-40 in light of the present remarks is respectfully requested.

In addition, Applicants have amended the claims by adding two new claims: Independent claims 41 and 42. The Office Action states in its numbered paragraph 3 that claims 6 and

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17 are allowable if rewritten in independent form. New claims 41 and 42 are claims 6 and 17 respectively rewritten in independent form including all the limitations of their base claims and any intervening claims and are therefore currently allowable.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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